

REMARKS

With the entry of this Amendment, claims 3-18 will be pending in this patent application.

ALLOWABLE SUBJECT MATTER

Applicant notes with appreciation the Examiner's recognition of allowable subject matter in claims 6, 7, 14 and 16, as presented in the Reply filed on June 23, 2006. In this paper, Applicant is canceling claim 14 and is amending claim 8 to incorporate all of the limitations of claim 14. Applicant is adding claim 18, which presents the earlier iteration of claim 6 in independent form. Applicant is also adding new claim 17, which depends from amended claim 8 and is amending claims 3, 5, 11, 12 and 13 for proper dependency and enhanced clarity. For reasons presented below, Applicant trusts that the Examiner will find all of the claims now pending in this application to be allowable.

PRIOR ART REJECTION I

Claims 4, 5, 8 and 11-13 were rejected under 35 USC § 103(a) as being unpatentable over JP 2001-029523 (JP '523) in view of US 5295686 (Lundberg), US 3751035 (Lockwood), US 6379262 B1 (Boone), US 5669824 (Aizawa et al.) and JP 9-192270 (JP '270). Applicant traverses this rejection insofar as it might be deemed applicable to any of claims 4, 5, 8, 11-13 and 17 as now presented.

Without acquiescing in the rejection, Applicant is amending independent claim 8 to incorporate all of the subject matter that had been recited in claim 14 and is canceling claim 14. Applicant is also amending claim 8 by deleting the recitation of the horizontal distance S1 and is now reciting this subject matter in new dependent claim 17.

The Examiner recognized claim 14 as reciting allowable subject matter. Since claim 8 now includes all of the subject matter that had been recited in claim 14, Applicant trusts that the Examiner will now find amended claim 8 to be allowable, even though the claim does not include the recitation of the horizontal distance S1.

In discussing the allowable subject matter, on page 9 of the outstanding Office Action, the Examiner stated that "none of the prior art discloses or renders as obvious weight members located as defined by the claim in addition to the other elements of structure claimed." Applicant

submits that the combination of elements that was recited in claim 14, apart from the recitation of the horizontal distance S1, defined a clearly patentable departure from the prior art and was recognized as such by the Examiner.

The iron-type golf club disclosed by JP '523 includes a face plate having thin and thick portions and a main body with an opening surrounded by a support for a peripheral edge portion of the face portion. The Examiner correctly observes that JP '523 does not offer a disclosure of a set of set of iron-type golf clubs in which there are three or more irons with different lofts, and in which a horizontal distance between a face center and a center of figure of the thin portion satisfies the requirements of claim 8.

The Examiner cites Lundberg as disclosing a set of three or more irons with different lofts and in which the center of gravity varies due to differing shapes and locations of thin and thick portions in irons having different lofts. As Applicant observed in the Reply filed on June 23, 2006, in the iron-type golf club sets disclosed by Lundberg, the weighting of the club heads varies so as to locate the center of gravity of the less lofted clubs toward the heel of the club head and locate the center of gravity of the more lofted clubs toward the toe. See, for example, column 3, lines 56-65. As disclosed by Lundberg, Figs. 13 and 14 illustrate a "mechanism for varying the center of gravity locations." For the 9-iron illustrated in Fig. 13, the shape and location of the raised portion 22 locates the center of gravity "on the toe side of center plane 14." (The center plane 14 is illustrated, for example, in Fig. 10.) For the 2-iron illustrated in Fig. 14, the shape and location of the raised portion 22' locates the center of gravity "on the heel side of center plane 14."

The Examiner cites Lockwood, Boone and JP '270 for disclosures of an iron head in which the sweet spot coincides with the location of a minimum thickness of the head and cites Aizawa for a disclosure of an iron head in which the sweet spot coincides with the location of a minimum thickness of the head and also with the center of figure of the thin portion. The Examiner contends that a combination of the disclosures in JP '523, Lundberg, Lockwood, Boone, Aizawa et al. and JP '270 would have been obvious to one of ordinary skill in the art and the golf clubs resulting from the combination would meet the requirements of Applicant's claims.

Without acquiescing in the Examiner's characterizations of the disclosures in the applied prior art and without acquiescing in the Examiner's proposal to combine the disclosures in these references, Applicant observes that the applied prior art references, whether individually, or in any reasonable combination, cannot, as acknowledged by the Examiner, meet the claimed requirements for locations of weight members in different lofted members of the golf club set. Thus, even if these disclosures were combined as the Examiner proposes, the resulting set of irons would not satisfy the requirements of amended claim 8.

In view of the foregoing observations, Applicant submits that no reasonable combination of the disclosures in JP '523, Lundberg, Lockwood, Boone, Aizawa et al. and JP '270 can properly serve as a basis for rejecting any of claims 4, 5, 8, 11-13 and 17, as now presented, under 35 USC § 103(a).

PRIOR ART REJECTION II

Claim 3 was rejected under 35 USC § 103(a) as being unpatentable over JP '523, Lundberg, Lockwood, Boone, Aizawa et al. and JP '270 and further in view of US 4874171 (Ezaki et al.). Applicant traverses this rejection insofar as it might be deemed applicable to claim 3 as now presented.

The Examiner characterizes Ezaki et al. as disclosing golf clubs with a center of gravity depth that is smaller for more lofted clubs than it is for less lofted clubs and asserts that it would have been obvious to incorporate the variable depth center of gravity feature of Ezaki et al. into the golf clubs resulting from the combined disclosures in JP '523, Lundberg, Lockwood, Boone, Aizawa et al. and JP '270.

Without acquiescing in the Examiner's proposal to combine the disclosure in Ezaki et al. with the other applied prior art, Applicant observes that Ezaki et al. cannot remedy deficiencies in the combination of the other applied prior art vis-à-vis the requirements of the claims as identified above.

In view of the foregoing observations, Applicant submits that no reasonable combination of the disclosures in JP '523, Lundberg, Lockwood, Boone, Aizawa et al., JP '270 and Ezaki et al. can properly serve as a basis for rejecting claim 3, as now presented, under 35 USC § 103(a).

PRIOR ART REJECTION III

Claims 9-10 and 15 were rejected under 35 USC § 103(a) as being unpatentable over JP '523, Lundberg, Lockwood, Boone, Aizawa et al. and JP '270 and further in view of US 5885166 (Shiraishi) and US 4848747 (Fujimura et al.). Applicant traverses this rejection insofar as it might be deemed applicable to any of claims 9-10 and 15 as now presented.

The Examiner cites Shiraishi as disclosing a set of irons including at least one each of a long iron, a middle iron and a short iron and cites Fujimura et al. as disclosing irons having back cavities in different locations. The Examiner asserts that it would have been obvious to add the different length/lofted irons feature of Shiraishi, and the differing locations of thin and thick portions of Fujimura et al. to the clubs resulting from the combination of the other applied prior art.

Again, Applicant would simply observe that the disclosures in Shiraishi and Fujimura et al. cannot remedy deficiencies in the disclosures in the combination of the other applied prior art vis-à-vis the requirements of the claims as identified above.

In view of the foregoing observations, Applicant submits that no reasonable combination of the disclosures in JP '523, Lundberg, Lockwood, Boone, Aizawa et al., JP '270, Shiraishi and Fujimura et al. can properly serve as a basis for rejecting any of claims 9-10 and 15, as now presented, under 35 USC § 103(a).

CONCLUSION

In view of the amendments, observations and arguments presented herein, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection stated in the Final Rejection and recognize all of the pending claims as allowable.

If unresolved matters remain in this application, the Examiner is invited to contact Frederick R. Handren, Reg. No. 32,874, at the telephone number provided below, so that these matters can be resolved expeditiously.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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